



Docket No.: TEI-0122
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ieyasu Kobayashi et al.

Application No.: 09/914,033

Confirmation No.: 8235

Filed: August 22, 2001

Art Unit: 3654

For: POLYESTER FILM ROLL

Examiner: W. A. Rivera

PETITION UNDER 37 C.F.R. § 1.181

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

This is in response to the Non-Final Office Action dated September 2, 2009.

Applicant, through its undersigned attorney, hereby petitions to withdraw the rejection of claims 6, 9, 13-15, and 23 in this case.

Accordingly, this Petition pursuant to 37 C.F.R. §1.181 is proper.

ARGUMENTS

I. Reversal Of The Rejection Of Claims 1-24 In The Decision On Appeal

Reversal of claims 1-3 and 16-18 - Page 2 of the Final Office Action of August 10, 2004 indicates a rejection of claims 1-3 and 16-18 under 35 U.S.C. §102 as allegedly being anticipated by U.S. Patent No. 4,576,344 to Sasaki et al. (Sasaki).

Within the Decision on Appeal of April 30, 2009, the Board of Patent Appeals and Interferences (“the Board”) has reversed the Final Rejection as to the rejection of claims 1-3 and 16-18.

Reversal of claims 4-15 and 19-24 - Page 2 of the Final Office Action of August 10, 2004 indicates a rejection of claims 4-15 and 19-24 under 35 U.S.C. §103 as allegedly being unpatentable over Sasaki.

The Board additionally reversed the Final Rejection as to the rejection of claims 4-15 and 19-24.

II. New Ground Of Rejection

While the Board has reversed the rejection of claims 1-24 made within the Final Office Action of August 10, 2004, the Decision on Appeal has entered a new ground of rejection only as to claims 1-5, 12, 16-22, and 24.

No new ground of rejection has been entered as to claims 6-11, 13-15, and 23.

III. Option To Reopen Prosecution Is Exercised

Pursuant to 37 C.F.R. §41.50(b), when the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution.
- (2) Request rehearing.

The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. 37 C.F.R. §41.50(b).

IV. Amendment After Decision On Appeal

An Amendment After Decision on Appeal was filed on June 23, 2009.

This Amendment is believed to overcome the new ground of rejection stated in the Decision.

Specifically, this Amendment:

Canceled claims 1-5, 12, 16-22, and 24 newly rejected in the Decision on Appeal;

Canceled claims 7-8 and 10-11; and

Placed claims 6, 9, 13-15, and 23 into independent form. No additional features have been added to those claims.

V. Non-Final Office Action

In response to the Amendment of June 23, 2009, the Non-Final Office Action indicates the reopening of prosecution in the instant application (Office Action at page 2).

A. Reopening Prosecution Following Decision On Appeal

Practice and procedures within the U.S. Patent and Trademark Office (USPTO) pursuant to 37 C.F.R. §1.198 dictate that:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

B. Approval For Reopening Prosecution

Practice and procedures pursuant to M.P.E.P. §1214.04 dictate that:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 C.F.R. §1.198 for the purpose of entering the new rejection.

Here, written authority of the Technology Center (TC) Director for reopening prosecution as been placed on page 6 of the Office Action.

C. Claims 6 and 9

Page 2 of the Final Office Action of August 10, 2004 indicates a rejection that includes the rejection of claims 6 and 9 under 35 U.S.C. §103 as allegedly being unpatentable over Sasaki.

The Decision on Appeal of April 30, 2009 has reversed the rejection of claims 6 and 9 without the entry of a new ground of rejection as to these claims.

As previously noted, the reopening prosecution is permissible only for the consideration of matters not already adjudicated, sufficient cause being shown. 37 C.F.R. §1.198.

Nevertheless, page 2 of the Office Action of September 2, 2009 indicates a rejection of claims 6 and 9 under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent No. 4,576,344 (Sasaki) which is the same reference that has been cited in the Final Office Action of August 10, 2004.

Here, the use of Sasaki as the lone reference in rejection under 35 U.S.C. §103 of claims 6 and 9 was already adjudicated. Specifically, page 10 of the Decision on Appeal reversed the final rejection of claims 6 and 9 under 35 U.S.C. §103 by holding that:

The Examiner has not articulated any reason why one having ordinary skill in the art would have been led to modify the film roll of Sasaki to have dimensions based on limiting the maximum diameter and the minimum diameter of the film roll.

The use of Sasaki in rejecting claims 6 and 9 has been already adjudicated within the Decision on Appeal of April 30, 2009.

Here, it is respectfully submitted that the rejection of claims 6 and 9 in the Office Action of September 2, 2009 using the same reference that has been previously applied in an Office Action and subsequently reversed in a Decision on Appeal is contradictory with USPTO policies and procedures established by 37 C.F.R. §1.198.

D. Relief Pertaining To Claims 6 and 9

In view of the arguments presented hereinabove, Applicant hereby petitions the Commissioner under 37 C.F.R. §1.181 to direct the examiner to withdraw the rejection of claims 6 and 9 under 35 U.S.C. §103 that is present within the Office Action dated September 2, 2009.

E. Claims 13-15 and 23

Page 2 of the Final Office Action of August 10, 2004 indicates a rejection that includes the rejection of claims 13-15 and 23 under 35 U.S.C. §103 as allegedly being unpatentable over Sasaki.

The Decision on Appeal of April 30, 2009 has reversed the rejection of claims 13-15 and 23 without the entry of a new ground of rejection as to these claims.

As previously noted, the reopening prosecution is permissible only for the consideration of matters not already adjudicated, sufficient cause being shown. 37 C.F.R. §1.198.

Nevertheless, page 3 of the Office Action of September 2, 2009 indicates a rejection of claims 13-15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sasaki, which is the same reference that has been cited in the Final Office Action of August 10, 2004, in view of U.S. Patent No. 4,911,951 (Ogawa).

Page 4 of the Office Action of September 2, 2009 contends that:

With respect to Claims 13-15, Sasaki et al teach a polyester film roll 4 free from wrinkles and rolled on a core 2; the film roll having a maximum diameter and a minimum diameter when all diameters are measured along the width direction of the roll; and the difference R between the minimum diameter value is not more than $2W \times 10^{-3}$ because the width of the roll is uniform throughout the roll and such is the case for the condition $L \times 10^{-7}$; wherein the polyester film is a film used for the support of a magnetic recording medium (see column 8, lines 55-57).

Regarding claim 23, page 5 of the Office Action of September 2, 2009 contends that:

Sasaki et al do not mention the specific dimensions of the length of the lines. However, it would have been an obvious matter of design choice, as determined through routine experimentation and optimization, to dimension the length of the lines of Sasaki et al as specified in Claim 23, lines 12-13 because one of ordinary skill would have been expected to have routinely experimented to determine the optimum dimensions for a particular use.

In response to these assertions, the use of Sasaki in the manner relied upon within the present rejection under 35 U.S.C. §103 of claims 13-15 and 23 was already adjudicated.

As previously highlighted, page 10 of the Decision on Appeal reversed the final rejection of claims 13-15 and 23 under 35 U.S.C. §103 by holding that:

The Examiner has not articulated any reason why one having ordinary skill in the art would have been led to modify the film roll of Sasaki to have dimensions based on limiting the maximum diameter and the minimum diameter of the film roll.

The use of Sasaki in rejecting claims 13-15 and 23 has been already adjudicated within the Decision on Appeal of April 30, 2009.

Here, it is respectfully submitted that the rejection of claims 13-15 and 23 in the Office Action of September 2, 2009 Sasaki is contradictory with USPTO policies and procedures established by 37 C.F.R. §1.198.

F. Relief Pertaining To Claims 13-15 and 23

In view of the arguments presented hereinabove, Applicant hereby petitions the Commissioner under 37 C.F.R. §1.181 to direct the examiner to withdraw the rejection of claims 13-15 and 23 under 35 U.S.C. §103 that is present within the Office Action dated September 2, 2009.

VI. Fees

No fee is believed required to support this petition. See 37 C.F.R. §1.181.

However, if any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: November 18, 2009

Respectfully submitted,

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